

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.
Claims 5-13, 15, and 17 remain pending.

Allowed Claims

Applicant appreciates the Examiner's indication that claims 12, 13, 15, and 17 are allowed. For at least reasons presented below, Applicant respectfully submits that all pending claims should be indicated as allowable.

Prior Art Rejections

1. **Fukuoka - Sacca**

Claims 5, 6, 8, and 9 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* (U.S. Patent 6,104,430) in view of *Sacca* (U.S. Patent 6,380,967). This rejection is respectfully traversed.

Claim 5

By way of review, claim 5 (like claims 6, 8, and 9) is directed to an image communication system in which an image processing apparatus and a first portable phone can communicate data with each other and in which the first portable phone can communicate with the second portable phone via a telephone line and in which the first portable phone sends an image data reduction instruction to the image processing apparatus. The image processing apparatus of claim 5 includes: an instruction receiving device for receiving the image data reduction instruction sent from the first portable phone; a data quantity reducing device for

reducing a data quantity of image data according to the image data reduction instruction received by the instruction receiving device; and a first image data transmitting device for transmitting, to the first portable phone, the image data of which the data quantity is reduced by the data quantity reducing device. The first portable phone of claim 5 includes: an image data receiving device for receiving the image data sent from the first image data transmitting device of the image processing apparatus; and a second image data transmitting device for transmitting via the telephone line the image data received by the image data receiving device.

In claim 5, the first portable phone further includes: a reduction ratio receiving device for receiving data representing a reduction ratio sent from the second portable phone via the telephone line, and a reduction ratio transmitting device for transmitting, to the image processing apparatus, the reduction ratio data received by the reduction ratio receiving device. In claim 5, the image processing apparatus further includes a reduction ratio data receiving device for receiving the reduction ratio data transmitted from the reduction ratio transmitting device of the first portable phone; and the data quantity reducing device reduces image data according to a reduction ratio associated with the reduction ratio data received by the reduction ratio data receiving device.

The primary reference, Fukuoka, discloses a digital electronic camera 30 (deemed by the Examiner as the claimed "image processing apparatus"), which is capable of transferring captured images to a telephone 32, which may be a portable telephone or a phone connected to a conventional public service telephone network (PSTN). See column 3, lines 57; Fig. 3.

The secondary reference, Sacca, discloses a video phone system in which a video fax 100 (deemed by the Examiner as an "image processing apparatus") is capable of sending image data

generated by the video camera 102 for transmission to a remote location. As stated on page 2 of the Office Action, the Examiner relies on an embodiment described at column 11, lines 2-18, in which a user is able to remotely select, via keys on a phone 108, either high resolution or low resolution image data for transmission.

Despite this embodiment, Applicant maintains that Sacca fails to suggest modifying the system of Fukuoka such that the portable phone 32 therein sends data quantity reducing instructions to the digital camera 30 to control the data quantity to be transmitted to a second portable phone.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

At least for the above reason, the asserted combination of *Fukuoka* and *Sacca* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 5.

Claim 6

In the image communication system of claim 6, at least one of the first portable phone and the image processing apparatus includes detecting means for detecting a data communication speed on the telephone line, and the data quantity reducing device of the image processing apparatus increases a quantity of data reduction when a slower communication speed is detected by the detecting means.

In rejecting claim 6, the Examiner cites Fig. 15 and col. 12, lines 40-48 of *Fukuoka* as allegedly teaching these features. See, Office Action page 10. This cited portion of *Fukuoka* states that:

Depending upon the communication capabilities such as bandwidth of the type of I/O card, the CPU selects operating parameters of the camera in order to make the best use of the available I/O capabilities. The parameters which can be set based on the capabilities of the I/O card are described in the flowchart of FIG. 15.

Thus, in *Fukuoka*, the CPU selects operating parameters of the camera based on the communication capabilities such as bandwidth of the type of I/O card being used. There is no teaching in *Fukuoka*, however, that the operating parameters of the camera are based upon communication speed of a telephone line or that a quantity of data reduction is increased when the telephone line has a slower communication speed.

At least for this reason, the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 6.

Claim 8

In the image communication system of claim 8, the image processing apparatus further includes an image data recording device for compressing image data received and for recording the image data compressed on a recording medium and the image data quantity reducing device reduces the data quantity of image data by compressing the image data according to a compression ratio higher than a compression ratio used to compress data in the recording of the data on the recording medium.

In rejecting claim 8, the Examiner cites col. 5, lines 48-57 and col. 12, lines 40-42 of *Fukuoka* as allegedly teaching these features. See, Office Action page 14. Even if it can be concluded, however, that *Fukuoka* discloses that the image data compression/expansion circuit 12 compresses image data based on bandwidth limitations, Applicant submit that the compression ratio therein would determined based upon bandwidth limitations of the I/O card itself, not based on a compression ratio used to compress data in the recording of data on a recording medium as recited in claim 8.

At least for this reason, Applicant respectfully submits that the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 8.

Claim 9

In the image communication system of claim 9, the image processing apparatus further includes an image data recording device for compressing image data received and for recording the image data compressed on a recording medium and the image data quantity reducing device compresses data in a method different from a data compression method employed in the recording of the image data on the recording medium.

Therefore, according to claim 9, the image data is compressed by two different compression methods. One form of compressed image data is created by the image data quantity reducing device and the other form of compressed image data is created by the image data recording device. Thus, two types of compressed image data are created from the image data.

In rejecting claim 9, the Examiner cites Fig. 6, element 12, and col. 5, lines 48-57 of *Fukuoka* as allegedly teaching this feature. See, Office Action page 17. Applicant submits, however, that *Fukuoka* fails to teach or suggest two devices that create compressed image data of two types as claimed.

At least for this reason, Applicant respectfully submits that the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 9.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka* and *Sacca*.

2. *Fukuoka - Sacca - Catanzaro*

Claims 7 and 11 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Catanzaro*. This rejection is respectfully traversed.

Claim 7

In the image communication system of claim 7, the first portable phone includes a mode notifying device for notifying modes available in the first portable phone, the modes including an image data transmission mode, and the first portable phone transmits, when the image data transmission mode is selected from the modes notified by the mode notifying device, the image data reduction instruction to the image processing apparatus.

In rejecting claim 7, the Examiner cites col. 6, lines 59-63 and col. 8, lines 41-49 of *Catanzaro* as allegedly teaching these claimed features. See, Office Action page 21.

Catanzaro, however, fails to show a first portable phone that transmits the image data instruction to the image processing apparatus when the image data transmission mode is selected.

At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Catanzaro* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 7.

Claim 11

In the image communication system of claim 11, the first portable phone further includes a device for transmitting a transmission instruction of image data for printout to the image

processing apparatus. Claim 11 also recites that the image processing apparatus further includes: a device for receiving the print image data transmission instruction transmitted from the first portable phone; and control means for terminating the data quantity reduction processing by the image data quantity reducing device in response to reception of the print image data transmission instruction and for transmitting the image data before the data quantity reduction processing to the first portable phone.

In rejecting claim 11, the Examiner cites col. 3, lines 57-59 and col. 5, lines 36-38 of *Fukuoka* as allegedly teaching the “control means” of claim 11. See, Office Action page 24. Applicant submits, however, that *Fukuoka* fails to disclose or suggest the control function of terminating the data quantity reduction processing in response to reception of the print image data transmission instruction as claimed. At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Catanzaro* fails to establish *prima facie* obviousness of claim 11.

3. *Fukuoka - Sacca - Shiohara*

Claim 10 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Shiohara* (U.S. Patent 6,618,553). This rejection is respectfully traversed.

In the image communication system of claim 10, the image data of which the data quantity is to be reduced is associated with thumbnail data, and the first image transmitting device of the image processing apparatus transmits the thumbnail image data when the data quantity of the image data after the reduction of image data by the data quantity reducing means is in the vicinity of a data quantity of the thumbnail image data.

In rejecting claim 10, the Examiner cites col. 3, lines 1-23 and col. 7, lines 49-56 of *Shiohara* as allegedly teaching these features. See, Office Action page 29. Applicant submits, however, that *Shiohara* merely discloses that a digital camera is provided with a display device for displaying the thumbnail image and a printer for printing the thumbnail image, but fails to judge whether the data quantity of the image data after reduction is in the vicinity of a data quantity of the thumbnail image data as claimed.

At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Shiohara* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 10.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka*, *Sacca*, and *Shiohara*.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant respectfully petitions for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$120.00 in payment of the extension of time fee is attached.

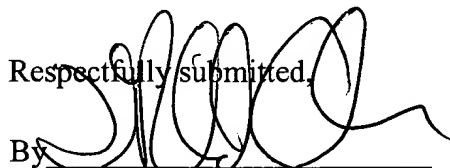
Application No. 09/628,546
Amendment dated September 20, 2005
After Final Office Action of May 20, 2005

Docket No.: 0905-0245P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 20, 2005

Respectfully submitted,



By
D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant